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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,657	06/28/2001	Jennifer L. Hillman	PF-0421-2 DIV	1636

27904 7590 12/02/2002

INCYTE GENOMICS, INC.  
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EXAMINER
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HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 12/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/894,657

Applicant(s)

HILLMAN ET AL.

Examiner

Alana M. Harris, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 8.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: Restriction Election Facsimile Transmission.

***Election/Restrictions***

1. The election/restriction requirement mailed September 30, 2002 has been vacated and a new election/restriction requirement is set forth below.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I-III. Claim 1, drawn to an isolated polypeptide, wherein the said polypeptide is SEQ ID NO: 1 (APOP-1); SEQ ID NO: 3 (APOP-2); and SEQ ID NO: 5 (APOP-3), respectively, classified in class 530, subclass 350.
  - IV-VI. Claims 10, 30, 31, 33, 35-42, 51 and 52, drawn to an isolated antibody that specifically binds to a polypeptide, wherein the said polypeptide is SEQ ID NO: 1 (APOP-1); SEQ ID NO: 3 (APOP-2); and SEQ ID NO: 5 (APOP-3), respectively, classified in class 530, subclass 387.1.
  - VII-IX. Claims 29, 43 and 44, drawn to a diagnostic test used in a methods for detecting and purifying a polypeptide comprising using an isolated antibody that specifically binds to a polypeptide, wherein the said polypeptide is SEQ ID NO: 1 (APOP-1); SEQ ID NO: 3 (APOP-2); and SEQ ID NO: 5 (APOP-3), respectively, classified in class 436, subclass 512.
  - X-XII. Claims 32 and 34, drawn to a method of diagnosing a condition/disease administering comprising a composition of an isolated antibody that specifically binds to a polypeptide, wherein the said polypeptide is SEQ ID

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NO: 1 (APOP-1); SEQ ID NO: 3 (APOP-2); and SEQ ID NO: 5 (APOP-3), respectively, classified in class 514, subclass 8.

3. The inventions are distinct, each from the other because of the following reasons:

Groups I-VI are structurally and functionally different products, which are made by different methods and have different uses.

The methods of Groups VII-XII differ in the method objectives, method steps and parameters and in the reagents used. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

Inventions of Groups X-XII and Groups VII-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups X-XII are drawn to *in vivo* methods and Groups VII-IX are drawn to *in vitro* methods.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. A telephone call was made to David G. Streeter, Ph.D. on September 30, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (703) 306-5880. The examiner can normally be reached on 6:30 am to 4:00 pm, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4315 for regular communications and (703) 308-4315 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

**ALANA HARRIS**  
**PATENT EXAMINER**



Alana M. Harris, Ph.D.  
December 2, 2002